

U. S. Application No. 10/978,524
Group Art Unit: 1762
Page 6 of 10

REMARKS

Claims 1-21 are pending in the present application. The Office Action of February 25, 2005, withdrew claims 11-21 from consideration as being subject to a final restriction requirement. The Specification was objected to for including informalities. The Office Action rejected claim 2 under 35 U.S.C. §112, second paragraph, as being indefinite. The Office Action also rejected claims 1-12 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 6, 8, 10, 11, 13, 16, 18-20, 23, 25, 30, 33, and 40-43 of Knauf (U.S. Pat. No. 6,656,401). Additionally, the Office Action rejected claims 1, 3-4, and 6-11 under 35 U.S.C. §103(a) as unpatentable over Backwell (U.S. Pat. No. 3,620,872) in view of Marrocco, III et al. (U.S. Pat. No. 5,646,231). Furthermore, the Office Action rejected claims 1-4 and 8-11 under 35 U.S.C. §103(a) as unpatentable over Peterson (U.S. 3,840,421) in view of Backwell and in further view of Marrocco, III et al. Finally, the Office Action rejected claim 12 under 35 U.S.C. §103(a) as unpatentable over Backwell in view of Marrocco, III et al. and in further view of Enlow et al. (U.S. Pat. No. 6,254,712).

Objections to the Specification

The Office Action objected to the Specification for omitting the serial number of the commonly assigned application incorporated by reference on page 9, line 13. Applicant appreciates the Examiner's identification of this typographical error and, as indicated above, has amended the Specification to correctly refer to Application Serial No. 10/721,957 entitled "Method for Extrusion Coating Multiple Webs." Accordingly, the objection is thereby satisfied.

Rejection Under §112, Second Paragraph

The Office Action next rejected claim 2 under §112, second paragraph, for containing informalities. Specifically, the Examiner stated that claim 2 calls for "the polymer film coating" but proper antecedent basis was not established. However, Applicant respectfully disagrees and refers to the second element of claim 1, which, in part, calls for "extruding a polymer film coating." Accordingly, Applicant believes that the claim 2 does not include any informalities and, thus, the rejection of claim 2 under §112, second paragraph, must be removed. However, Applicant has amended claim 2 to clarify the claimed invention and improve readability.

U. S. Application No. 10/978,524
Group Art Unit: 1762
Page 7 of 10

Double Patenting

The Office Action rejected claims 1-12 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 6, 8, 10, 11, 13, 16, 18-20, 23, 25, 30, 33, and 40-43 of U.S. Pat. No. 6,656,401 ('401 Patent). While Applicant does necessarily agree with the interpretation of claims 1-12 of the present application or claims 1-3, 6, 8, 10, 11, 13, 16, 18-20, 23, 25, 30, 33, and 40-43 of the '401 Patent, in an effort to further prosecution of an application that has been pending for nearly four years, Applicant hereby submits a Terminal Disclaimer. That is, by way of separate document, enclosed herewith, Applicant submits a Terminal Disclaimer disclaiming the terminal part of any patent granted on the instant application that would extend beyond the expiration date of the '401 Patent. Applicant notes that the filing of the Terminal Disclaimer simply serves the statutory function of removing the rejection of double patenting and raises neither a presumption nor estoppel on the merits of the rejection. See MPEP § 804.02, citing Quad Environmental Technologies Corp. v. Union Sanitary District, 946 F.2d 720, 20 USPQ2d 1392 (Fed. Cir. 1991).

Accordingly, withdrawal of the rejection of claims 1-12 under obviousness-type double patenting is respectfully requested.

Rejections Under §103(a)

The Office Action rejected claims 1, 3-4, and 6-11 as being unpatentable over Backwell in view of Marrocco, III et al. While the Office Action included a detailed explanation to support the rejection, Applicant respectfully disagrees with the proffered interpretation of the claimed invention as well as the art and application thereof.

Backwell teaches a method for making a multi-layer web laminated material using a reusable carrier. See Title and Background of Backwell. In particular, Backwell teaches "a carrier web 2...coated with a layer 4 to 12 grams per square meter...followed by the application of print 6." Col. 2, ll. 5-8. Backwell states, "A suitable primer was applied on the printed surface before an extrusion coating of...polyethylene film 8." Col. 2, ll. 8-11. The Office Action acknowledged that Backwell does not teach that the extrusion coating is separable from the carrier web, as called for in claim 1.

In an attempt to rectify this deficiency, the Office Action cited column 21, lines 5-9 of Marrocco, III et al., which states, "Coatings may also be formed by any of the established techniques, including but not limited to: coating from solution, spray coating of solution, spin coating, coating

U. S. Application No. 10/978,524
Group Art Unit: 1762
Page 8 of 10

from a latex, powder coating, laminating preformed films, spray coating molten droplets, and coating from the melt." From this statement, the Office Action concluded, "In other words, Marrocco III et al teach that laminating preformed films is *functionally equivalent* to coating from melt, solution or latex." (Emphasis added).

Applicant respectfully disagrees and does not believe that the asserted conclusion is supported by the cited section or by any portion of Marracco, III et al. Rather, Marracco, III et al. is directed to rigid-rod polymers and blending the polymers with thermoplastic polymers to achieve improved strength properties for high performance composite materials. See Col. 1, ll. 15-25. In this regard, Marrocco III et al. teaches that the various blends were tested using these commercial coating and film forming processes but did *not* state that polymer coatings were "functionally equivalent" no matter how they are processed. Rather, one of ordinary skill in the art would readily recognize that laminating preformed films does not necessarily yield a "functional equivalent" to coatings created by various processes.

For at least these reasons, Applicant does not believe that the proffered rejection is sufficient to establish a *prima facie* case of obviousness because the combination does not teach or suggest the claimed processes including "separating the extraction-coated lightweight web from the carrier web." Accordingly, Applicant believes claim 1 is patentably distinct from the art of record.

Though, as addressed above, the Office Action rejected claims 1, 3, 4, and 8-11 as unpatentable over Backwell in view of Marrocco, III et al., the Office Action next rejected claims 1-4 and 8-11 as unpatentable over Peterson in view of Backwell and in further view of Marrocco, III et al. Thus, with the notable addition of claim 2, the Office Action provided two distinct bases of rejection for claims 1, 3, 4, and 8-11. Nevertheless, as shown above claim 1 is patentably distinct from the combination of Backwell in view of Marrocco, III et al. Accordingly, for at least the reasons stated above, the proffered combination does not teach or suggest that which is called for in claim 1 and, as will be shown, the addition of Peterson does not overcome this point.

Peterson is directed to a stainless steel carrier belt. An adhesive is combined with a stretchable vinyl material to prevent slippage or wrinkling of the vinyl film. A printing layer is applied thereon and covered with a protective clear vinyl. The combination of the stretchable vinyl material, the printing, and the protective clear vinyl layer are then stripped from the adhesive to form the desired product.

U. S. Application No. 10/978,524
Group Art Unit: 1762
Page 9 of 10

It appears that the Office Action attempted to equate the protective clear vinyl with the extrusion coating called for in claim 1 based on the statement that "Peterson fails to teach that the protective clear vinyl material 72 is added to the web 44 by extrusion coating." However, such an interpretation is unsupported by the art of record and cannot be said to teach or suggest the claimed invention.

That is, Peterson teaches that clear vinyl is used to protect the ink (e.g. from being scratched or scuffed). See col. 4, ll. 59-61. However, it is *not* adhered to the print because applying an extrusion coating over the print would bond the coating to the film and make it unusable. One of ordinary skill in the art will readily recognize that these types of films are commonly used for advertisements and markings that can be applied to glass windows. In this regard, the vinyl film sticks to glass without adhesive and the protective vinyl is peeled away from the print just prior to applying the film to the glass.

Additionally, Peterson teaches that when using a carrier web to support a lightweight web a low tack adhesive is necessary to keep the product from wrinkling in a nip such as a print press nip. While this teaching of Peterson is well known in the art, the present invention overcomes this specific limitation of Peterson by using the extrusion coating to tack down the lightweight web to the carrier at the edges by the strength of the polymer coating. Thus, no adhesive is needed. In this regard, one of ordinary skill in the art would not look to Peterson when attempting to create the claimed invention because Peterson teaches a system and method plagued by one of the particular drawbacks overcome by the present invention.

Therefore, for at least these reasons, the rejection presented in the Office Action cannot be sustained. Accordingly, Applicant believes claim 1 is allowable.

Though the Office Action also rejected claims 2-12 under 35 U.S.C. §103(a) as being unpatentable over various combinations of Backwell, Marrocco, III et al., Peterson, and Enlow et al., Applicant respectfully disagrees with respect to the art as applied. However, in light of claims 2-12 depending from what are believed otherwise allowable claims, Applicant does not believe additional remarks are necessary.

Conclusion

Applicant respectfully asserts that all objections and rejections asserted in the Office Action have been overcome. In particular, in light of the foregoing, Applicant believes the previous bases of

U. S. Application No. 10/978,524
Group Art Unit: 1762
Page 10 of 10

rejection presented against claims 1-12 have been overcome. Accordingly, the application is in condition for allowance, and a Notice of Allowance is respectfully requested. As always, the Examiner is invited to contact the undersigned at the telephone number appearing below if such would advance the prosecution of this application.

The Commissioner is hereby authorized to deduct the \$1,020.00 fee for a three-month extension of time by a large entity, along with any additional fees arising as a result of this Amendment or any other communication, from Deposit Account No. 17-0055.

Respectfully submitted,

GARY H. KNAUF



John D. Franzini
Reg. No. 31,356
Attorney for Applicants
Quarles & Brady LLP
411 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-4497
Tel. No. (414) 277-5747

QBMKE5775915.1